TJQ/Nickens

All communications respecting this case should identify it by number and names of parties.

Paper No.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 68,799

Universal City Studios, Inc.

v.

Nintendo of America Inc.

MAILED

JAN 3 1985

PAT. & T. M. OFFICE

Opposer's withdrawal, filed November 5, 1984, is noted. Since no answer is of record, the opposition is dismissed without prejudice. See Trademark Rule 2.106(c).

#7

J. E. Rice

L. E. Rooney

R. L. Simms

Members, Trademark
Trial and Appeal Board

MAIL ROOM
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1994

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSAL CITY STUDIOS, INC.,	Opposition No. 67,904 Opposition No. 68,799 Opposition No. 68,800 Opposition No. 68,888
Opposer,	
-against-	Application SN 419,537 Application SN 416,262 Application SN 456,008
NINTENDO OF AMERICA, INC.,	
Applicant.	WITHDRAWAL OF OPPOSITIONS

#6

Pursuant to Trademark Rule 2.106(c), Opposer Universal City Studios, Inc. ("Universal") hereby withdraws its oppositions, without prejudice, in the following proceedings:

Opposition No. 67,904
Opposition No. 68,799
Opposition No. 68,800
Opposition No. 68,888

As can be seen from the rulings attached hereto as Exhibit 1, these four opposition proceedings were suspended prior to the interposition of an answer by the applicant, Nintendo of America, Inc. ("Nintendo"), pending the outcome of a civil action between the parties.

Universal also withdraws its oppositions, without prejudice, to the following applications filed by Nintendo, for which opposition numbers have not yet been assigned:

Exhibit 1

Application Serial No. 419,537 for the trademark "DONKEY KONG", published in the Official Gazette on August 14, 1984 at TM 187.

Application Serial No. 416,262 for the trademark "DONKEY KONG", published in the Official Gazette on August 14, 1984 at TM 187.

Application Serial No. 456,008 for the trademark "DONKEY KONG 3", published in the Official Gazette on August 21, 1984 at TM 437.

Respectfully submitted,

TOWNLEY & UPDIKE

By: _____

Dated: October 30, 1984

405 Lexington Avenue
New York, New York 10174
(212) 682-4567
Attorneys for Opposer

TO: John J. Kirby, Esq.
Mudge, Rose, Guthrie, Alexander
& Ferdon
180 Maiden Lane
New York, New York
Attorneys for Applicant
Nintendo of America, Inc.

CERTIFICATE

I hereby certify that this Withdrawal of Oppositions is being deposited in the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231, on November 1, 1984.

Sandra Edelman

SANDRA EDELMAN, ESQ.

AFFIDAVIT OF SERVICE

STATE OF NEW YORK)
: ss:
COUNTY OF NEW YORK)

CATHERINE CANTERINO, being duly sworn, deposes and says deponent is not a party to this action, is over]8 years of age and resides at One Rustic Ridge, Little Falls, New Jersey 07424. That on the 1st day of November, the within Withdrawal of Oppositions was served upon the following:

JOHN J. KIRBY, ESQ.
Mudge, Rose, Guthrie, Alexander
& Ferdon
180 Maiden Lane
New York, New York 10038
Attorney for Applicant

at the above address designated for that purpose by said attorney by depositing a true copy of same enclosed in a post-paid properly addressed wrapper in an official depository under the exclusive care and custody of the United States Post Office Department within the State of New York.

Catherine Canterino
Catherine Canterino

Sworn to before me this
1st day of November, 1984.

Linda Edel
Notary Public

SANDRA EDELMAN
Notary Public, State of New York
No. 31-4767632
Qualified in New York County
Commission Expires March 30, 1986

BAC/DiCocco

All communications respecting this case should identify it by number and names of parties.

Paper No.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Rec'd (M)	11-14-83
~~Served~~ MAILED	11-10-83
Entered	11-14-83
Filed	
L/D	
BY	

Opposition No. 67,904

Universal City Studios, Inc.

v.

Nintendo of America, Inc.

MAILED

NOV 10 1983

PAT. & T. M. OFFICE

This case now comes up on applicant's motion to suspend this proceeding pending the outcome of a civil action between the parties, now in the United States District Court for the Southern District of New York. Opposer filed a response thereto agreeing that proceedings herein should be suspended pending the determination of the related litigation.

Applicant filed a copy of the complaint in the civil action.

It appears that the civil suit, which is the basis of applicant's motion to suspend, may well have a bearing on the issues involved in this opposition proceeding. That is, the civil action will have a bearing on the question of applicant's right to register the designation "DONKEY KONG" and design, which is the central question in this opposition proceeding.

Under these circumstances, it is believed that the proper course of action is to suspend all proceedings herein pending the final determination of the civil case.

Accordingly, applicant's motion to suspend proceedings is granted. Proceedings herein are suspended until termination of the civil suit. Within twenty days after termination of that case, the interested party should call up this opposition proceeding for appropriate action.

Beth A. Chapman

Attorney-Examiner,
Trademark Trial and
Appeal Board

TJO/Adgerson

Communications respecting case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Rec'd MAD	7-23-84
Served	
Entered	7-23-84
Filed	
L/D	
BY	JGS

Opposition No. 68,800

Universal City Studios, Inc.

v.

Nintendo of America Inc.

MAILED

JUL 11 1984

PAT. & T. M. OFFICE

This case now comes up on applicant's motion, filed May 14, 1984, for suspension of proceedings herein pending final determination of a civil action between the parties now on appeal in the United States Court of Appeals for the Second Circuit.(1) In support of its motion, applicant asserts that the issues in the two proceedings are essentially the same and that the civil action will have a bearing upon the issues pending in the instant opposition. Opposer has submitted its consent to applicant's motion.

The motion to suspend appears to be well taken. The civil action may have a bearing on the issues involved herein.

In view thereof, and inasmuch as opposer has consented thereto, the motion to suspend is granted. Trademark Rule 2.117(a). Within twenty days of a final determination of the

(1) No. 84-7095, styled Universal City Studios, Inc. v. Nintendo of America Inc.

civil action, the interested party should call up this case for appropriate action.

T. Jeffrey Quinn

T. Jeffrey Quinn
Attorney-Examiner,
Trademark, Trial and
Appeal Board

cc:

Townley & Updike
Chrysler Building
405 Lexington Avenue
New York, New York 10174

Christensen, O'Connor, Johnson &
Kindness
2701 Westin Building
2001 Sixth Avenue
Seattle, Washington 98121

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 68,888

Universal City Studios, Inc.

v.

Nintendo of America Inc.

MAILED

SEP 10 1984

PAT. & T. M. OFFICE

This case now comes up on applicant's motion to suspend this proceeding pending the outcome of a civil action between the parties now in the United States District Court for the Southern District of New York.(1) Opposer filed a response thereto agreeing that proceedings herein should be suspended.

Applicant filed copies of the pleadings in the civil action. It appears that the civil suit, which is the basis of applicant's motion to suspend, may well have a bearing on

(1) The decision of the United States District Court granting defendant's (applicant herein) motion for summary judgment has been appealed to the United States Court of Appeals for the Second Circuit, which appeal is now pending.

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Served	9-10-84
Entered	9-14-84
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L/D	
PY	JSS

the issues involved in this opposition proceeding. That is, the civil action will have a bearing on the question of applicant's right to register the designation "DONKEY KONG" which is the central question in this opposition proceeding.

Under these circumstances, it is believed that the proper course of action is to suspend all proceedings herein pending the final determination of the civil case.

Accordingly, applicant's motion to suspend proceedings is granted. Proceedings herein are suspended until termination of the civil suit. Within twenty days after termination of that case, the interested party should call up this opposition proceeding for appropriate action.

Beth Chapman

Beth A. Chapman
Attorney-Examiner, Trademark
Trial and Appeal Board

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...should identify it by
...and names of parties.

Rec'd MAD	6-25-84
Served fm	6-21-84
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BY	JSS

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 68,799

Universal City Studio, Inc.

v.

Ninteno of America Inc.

MAILED

JUN 21 1984

PAT. & T. M. OFFICE

This case now comes up on applicant's motion, filed May 14, 1984, for suspension of proceedings herein pending final determination of a civil action between the parties now on appeal in the United States Court of Appeals for the Second Circuit.(1) In support of its motion, applicant asserts that the issues in the two proceedings are essentially the same and that the civil action will have a bearing upon the issues pending in the instant oppositition. Opposer has submitted its consent to applicant's motion.

The motion to suspend appears to be well taken. The civil action may have a bearing on the issues involved herein.

(1) No. 84-7095 styled Universal City Studios, Inc. v. Nintendo of America, Inc.

In view thereof, and inasmuch as opposer has consented thereto, the motion to suspend is granted. Trademark Rule 2.117(a). Within twenty days of a final determination of the civil action, the interested party should call up this case for appropriate action.

T. Jeffrey Quinn
Attorney-Examiner
Trademark Trial and
Appeal Board

TJO/Huff

All communications respecting this case should identify it by number and names of parties.

Paper No. 5

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 68,799

Universal City Studio, Inc.

v.

Ninteno of America Inc.

MAILED

JUN 21 1984

PAT. & T. M. OFFICE

This case now comes up on applicant's motion, filed May 14, 1984, for suspension of proceedings herein pending final determination of a civil action between the parties now on appeal in the United States Court of Appeals for the Second Circuit.(1) In support of its motion, applicant asserts that the issues in the two proceedings are essentially the same and that the civil action will have a bearing upon the issues pending in the instant oppositition. Opposer has submitted its consent to applicant's motion.

The motion to suspend appears to be well taken. The civil action may have a bearing on the issues involved herein.

(1) No. 84-7095 styled Universal City Studios, Inc. v. Nintendo of America, Inc.

In view thereof, and inasmuch as opposer has consented thereto, the motion to suspend is granted. Trademark Rule 2.117(a). Within twenty days of a final determination of the civil action, the interested party should call up this case for appropriate action.

T. Jeffrey Quinn
Attorney-Examiner
Trademark Trial and
Appeal Board

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 378,948, published in the Official Gazette on December 20, 1983 at TM 323

UNIVERSAL CITY STUDIOS, INC.,

Opposer,

-against-

NINTENDO OF AMERICA, INC.,

Applicant.

Opposition No. 68,799

PAT. & T.M. OFFICE
MAY 31 1984
TRADEMARK TRIAL AND APPEAL BOARD

OPPOSER'S RESPONSE TO APPLICANT'S REQUEST FOR SUSPENSION OF PROCEEDINGS

Universal City Studios, Inc. ("Universal"), opposer herein, by its attorneys Townley & Updike, submits this response to the request by applicant Nintendo of America, Inc. ("Nintendo"), pursuant to Trademark Rule 2.117, for the suspension of proceedings regarding the application to register the mark DONKEY KONG JUNIOR, Serial No. 378,948.

Universal does not oppose Nintendo's request for a suspension of proceedings due to the pendency of a civil action between opposer and applicant entitled Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc.,

82 Civ. 4259 (RWS). As set forth in Nintendo's Request for Suspension of Proceedings, the United States District Court for the Southern District of New York granted Nintendo's motion for summary judgment dismissing Universal's Complaint on December 22, 1983, and Universal has appealed the district court's decision to the United States Court of Appeals for the Second Circuit, Universal City Studios, Inc. v. Nintendo of America, Inc., No. 84-7095. (See Exhibits A and B to this response, respectively, Universal's Memorandum of Law in Opposition to Defendant's Motion for Summary Judgment and Universal's Brief of Plaintiff-Appellant).

Universal agrees that the issues presented in the federal court action will either be dispositive of, or have some bearing on, Nintendo's application for registration of the trademark DONKEY KONG JUNIOR, Serial No. 378,948, and that the opposition proceedings pending herein should be suspended until termination of the federal court action.

Dated: May 24, 1984

Respectfully submitted,

TOWNLEY & UPDIKE

By: Douglas C. Fairhurst

Douglas C. Fairhurst
405 Lexington Avenue
New York, New York 10174
(212) 682-4567

Attorneys for Opposer

AFFIDAVIT OF SERVICE

STATE OF NEW YORK)
: ss.:
COUNTY OF NEW YORK)

DOROTHY M. MURPHY, being duly sworn, deposes and says deponent is not a party to this action, is over 18 years of age and resides at 2934 Valentine Avenue, Bronx, New York. That on the 25th day of May 1984 Opposer's Response to Applicant's Request For Suspension of Proceedings was served upon the following:

Mudge Rose Guthrie Alexander & Ferdon
180 Maiden Lane
New York, New York 10005

at the above address designated for that purpose by said attorney by depositing a true copy of same enclosed in a post-paid properly addressed wrapper in an official depository under the exclusive care and custody of the United States Post Office Department within the State of New York.

Dorothy M. Murphy

Sworn to before me this
25th Day of May, 1984.

Sandra Edelman

SANDRA EDELMAN
Notary Public, State of New York
No. 31-4707632
Qualified in New York County
Commission Expires March 30, 1986

AFFIDAVIT OF SERVICE

STATE OF NEW YORK)
: ss.:
COUNTY OF NEW YORK)

DOROTHY M. MURPHY, being duly sworn, deposes and says deponent is not a party to this action, is over 18 years of age and resides at 2934 Valentine Avenue, Bronx, New York. That on the 25th day of May 1984, Opposer's Response to Applicant's Request For Suspension of Proceedings was served upon the following:

Larry A. Jackson, Esq.
Christensen, O'Connor,
Johnson & Kindness
2001 Sixth Avenue
Seattle, WA. 98121

at the above address designated for that purpose by said attorney by depositing a true copy of same enclosed in a post-paid properly addressed wrapper in an official depository under the exclusive care and custody of the United States Post Office Department within the State of New York.

Dorothy M. Murphy
Dorothy M. Murphy

Sworn to before me this
25th day of May, 1984.

Sandra Edelman

SANDRA EDELMAN
Notary Public, State of New York
No. 31-4767632
Qualified in New York County
Commission Expires March 30, 1986

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

on May 25th, 1984

Sandra Edelman

Sandra Edelman, Esq.

PAT. & T.M. OFFICE
MAY 14 1984
TRADEMARK T
AND APPEAL B

MUDGE ROSE GUTHRIE ALEXANDER & FERDON

180 MAIDEN LANE
NEW YORK, N.Y. 10038
212-510-7000

2121 K STREET, N.W.
WASHINGTON, D.C. 200
202-429-9355

12, RUE DE LA PAIX
75002 PARIS, FRANCE
261-57-71

SUITE 2020
333 SOUTH GRAND AVEN
LOS ANGELES, CALIF. 90
213-613-1112

CABLE ADDRESS
BALTUCHINS - NEW YORK
TELEX: WU 703729
WU 127889

TELECOPIER
212-510-7824

NATHAN ABRAMOWITZ
JOHN L. ALTIERI, JR.
GEORGE F. ANDEREGG, JR.
THOMAS BARR IV
JOHN G. BOVE
WALTER E. BREEN
WILLIAM H. CANNON
ROBERT A. CANTOR
NICHOLAS J. CAPOZZOLI, JR.
ALAN F. CARIDDI
JOSEPH J. CARROLL
EUGENE J. CARRON
J. D. CLAYTON
JOSEPH C. DALEY
FREDERICK M. DANZIGER
JOEL DAVIDOW
MICHAEL A. DeANGELIS
DENNIS R. DEVENEY
MARTIN J. DOCKERY
THOMAS W. EVANS
RICHARD S. FARROW
ROBERT E. FERDON
JAMES G. FRANGOS
LAWRENCE J. GANNON
GERRIT GILLIS
ROBERT J. GILLISPIE
HOWARD W. GOLDSTEIN
JUDAH GRIBETZ
MICHAEL J. HANNIGAN
MATTHEW G. HEROLD, JR.
DANA W. HISCOCK
EUCLID A. IRVING
JOHN J. KIRBY, JR.
WILLIAM J. KRAMER
STANFORD G. LADNER
HAROLD G. LEVISON
JOHN C. LILLIE
EDWARD W. LONG
CARL F. LYON, JR.
WILLIAM A. MADISON
ARTHUR J. MAHON
FRANCIS X. MALONEY
JAMES P. MARLIN
GEORGE J. MARTIN, JR.
ARTHUR F. McMAHON, JR.
MITCHELL E. MENAKER
J. ROGER MENTZ
RICHARD H. NICHOLLS
DOUGLAS M. PARKER
ROBERT E. PEDUZZI
JED S. RAKOFF
THOMAS C. RUSSLER
NORMAN M. SEGAL
LAURENCE V. SENN, JR.
HARRY G. SILLECK, JR.
LARRY D. SOBEL
ARNOLD H. TRACY
DAVID A. VAUGHAN
WILLIAM N. WALKER
DONALD J. ZOELLER

COUNSEL

JOHN H. ALEXANDER
RANDOLPH H. GUTHRIE
FRANKLIN B. LINCOLN, JR.
MILTON C. ROSE
H. RIDGELY BULLOCK
OTTO G. STOLZ

May 14, 1984

hold 20

#3

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Washington, D.C. 20231

Attn: Trademark Trial and Appeal Board

Dear Sir or Madam:

Nintendo of America, Inc., by its attorneys, Mudge Rose Guthrie Alexander & Ferdon, hereby submits for filing Applicant's Request For Suspension of Proceedings in the following opposition proceeding: Universal City Studios, Inc. v. Nintendo of America, Inc., Opp. No. 68,799 (App. filed August 9, 1982).

Please acknowledge receipt of this document by stamping the copy of this letter enclosed for this purpose.

Sincerely,

Shelly B. O'Neill

Shelly B. O'Neill

Enclosure

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 378,948 for DONKEY KONG JUNIOR, applicant Nintendo of America, Inc., filed August 9, 1982, and published in the Official Gazette on December 20, 1983, at TM 323.

UNIVERSAL CITY STUDIOS, INC., Opposer, -against- NINTENDO OF AMERICA, INC., Applicant.	Opposition No. 68,799

REQUEST FOR SUSPENSION OF PROCEEDINGS
BY THE PATENT AND TRADEMARK OFFICE

Nintendo of America, Inc., ("Nintendo"), applicant herein, by its attorneys, Mudge Rose Guthrie Alexander & Ferdon, hereby requests that the proceedings regarding the published trademark application of Nintendo of America, Inc. for registration of the mark DONKEY KONG JUNIOR, Serial No. 378,948, for "Video Output Game Machines and Parts Therefor" and the opposition by Universal City Studios, Inc. ("Universal"), opposer herein, be suspended pursuant to Trademark Rule 2.117. This request is made because the applicant and opposer have been engaged in a civil action which will be dispositive of, or, at the very least, have some bearing upon the proceedings before this Board. As described below, the United States District Court for the Southern District of New York in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y.) has held, inter alia, that Universal has no

trademark rights in King Kong and that there is no likelihood of confusion as to the source of Donkey Kong. Universal's appeal of the district court's decision is presently pending before the United States Court of Appeals for the Second Circuit.

In its opposition to Nintendo's trademark application, Universal contends that "applicant's said mark DONKEY KONG JUNIOR so nearly resembles the KING KONG name and trademark KING KONG as to be likely, when applied to applicant's goods, to cause confusion, to cause mistake and to deceive with consequent injury to Opposer, to the trade and to the public." Universal Opposition ¶14. Universal made these same allegations in its complaint, filed on June 29, 1982, in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y.), in which it contended that Nintendo's trademark Donkey Kong and any similar mark infringed on Universal's claimed exclusive property and trademark rights in the name, character and story of King Kong, thereby constituting a violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125 (a), common law trademark infringement, unfair competition, trade name infringement and a violation of Section 368-d of the New York General Business Law. See Appendix A (Universal Complaint).

In the federal court action, Nintendo denied Universal's claims, asserted counterclaims (see Appendix B (Nintendo Answer)), and moved, after completion of discovery, for summary judgment dismissing Universal's complaint pursuant to Rule 56 of the Federal Rules of Civil Procedure. See Appendix C (Memorandum of Law in Support of The Defendants' Motion for Summary Judgment). Nintendo

argued that Universal's complaint should be dismissed as a matter of law because (1) Universal is estopped from asserting a trademark right in the King Kong property after having fully and successfully litigated the opposite position in a prior litigation, (2) Universal has no property or trademark rights in the name, character and story of King Kong that it can assert against Nintendo, (3) through its agreements with Nintendo's licensees, Universal has abandoned any alleged trademark claim in King Kong and admitted that Donkey Kong is not an infringement of King Kong, (4) the name, character and story of King Kong have lost any trademark significance they once may have had, (5) even if Universal owned a valid trademark interest in King Kong, there is no likelihood of any confusion as to the origin of Donkey Kong, and (6) Universal cannot establish the necessary elements for a dilution claim under Section 368-d of the New York General Business Law.

The United States District Court for the Southern District of New York heard oral argument on Nintendo's summary judgment motion on August 8, 1983, and on December 22, 1983, granted Nintendo's motion for summary judgment and dismissed Universal's complaint, finding, inter alia, that Universal has no trademark rights in King Kong and that there is no likelihood for confusion as to the source of Donkey Kong. See Appendix D (Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of America, Inc., 82 Civ. 4259 (S.D.N.Y. Dec. 22, 1983)). Universal appealed the district court's decision to the United States Court of Appeals for the Second Circuit in Universal City Studios, Inc. v. Nintendo Co., Ltd. and Nintendo of

America, Inc., No. 84-7095. The Second Circuit is scheduled to hear oral argument on the appeal on May 23, 1984.

Because the issues presented in the federal court action are essentially the same as and will be dispositive of or have some bearing upon the issues presented by Universal's opposition to Nintendo's application for registraton of the trademark DONKEY KONG JUNIOR, Serial No. 378,948, this Board should suspend the proceedings herein until termination of the pending litigation. This Board previously considered and granted on November 10, 1983, a similar request for suspension of proceedings regarding the published trademark application of Nintendo for registration of the mark DONKEY KONG & DESIGN, Serial No. 330,932, for electronic coin operated video games using a video display, and the opposition filed by Universal, Opposition No. 67,904. See Appendix E (Order of Trademark Trial and Appeal Board).

Nintendo of America, Inc., therefore, respectfully requests that the proceedings before the Trademark Trial and Appeal Board be suspended until termination of the federal court action. If this Board declines to grant this request for suspension, then Nintendo

respectfully requests that it be allowed thirty (30) days after such determination by the Board in which to file an answer to Universal's opposition.

Dated: May 11, 1984

Respectfully submitted,

MUDGE ROSE GUTHRIE ALEXANDER & FERDON

By: John J. Kirby, Jr. /SM
JOHN J. KIRBY, JR.
180 Maiden Lane
New York, New York 10038
(212) 510-7000

Attorneys for Nintendo of America, Inc.

OF COUNSEL:

Larry A. Jackson
CHRISTENSEN, O'CONNOR, JOHNSON & KINDNESS
2001 Sixth Avenue
Seattle, WA 98121
(206) 623-8780

BAC/ Rocco

All communications respecting this case should identify it by number and names of parties.

Paper No. 11-10

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 67,904

Universal City Studios, Inc.

v.

Nintendo of America, Inc.

MAILED

NOV 10 1983

PAT. & T. M. OFFICE

This case now comes up on applicant's motion to suspend this proceeding pending the outcome of a civil action between the parties, now in the United States District Court for the Southern District of New York. Opposer filed a response thereto agreeing that proceedings herein should be suspended pending the determination of the related litigation.

Applicant filed a copy of the complaint in the civil action.

It appears that the civil suit, which is the basis of applicant's motion to suspend, may well have a bearing on the issues involved in this opposition proceeding. That is, the civil action will have a bearing on the question of applicant's right to register the designation "DONKEY KONG" and design, which is the central question in this opposition proceeding.

Under these circumstances, it is believed that the proper course of action is to suspend all proceedings herein pending the final determination of the civil case.

Accordingly, applicant's motion to suspend proceedings is granted. Proceedings herein are suspended until termination of the civil suit. Within twenty days after termination of that case, the interested party should call up this opposition proceeding for appropriate action.

Beth A. Chapman

Attorney-Examiner,
Trademark Trial and
Appeal Board

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSAL CITY STUDIOS, INC., Opposer, -against- NINTENDO OF AMERICA, INC. Applicant.	NO. Opposition No. 68,799 AFFIDAVIT OF SERVICE UPON ATTORNEYS

State of New York, County of New York:

The UNDERSIGNED, who is not a party to this action or proceeding, being duly sworn, being over the age of 18 years and having an address in care of Mudge Rose Guthrie Alexander & Ferdon, 180 Maiden Lane, New York, New York 10038, states:

On May 11, 19 84, true copy(ies) of the paper(s) described below were served on respective attorneys for the parties by depositing the papers in an official depository of the U.S. Postal Service in New York City enclosed in a postage-paid envelope/wrapper duly addressed and sealed for the addresses that follow

DESCRIPTION OF PAPERS

Request for Suspension of Proceedings by the Patent and Trademark Office

ATTORNEYS SERVED

Douglas C. Fairhurst
Townley & Updike
405 Lexington Avenue
New York, New York 10174

Sworn to before me on
May 11, 1984

Andrea J. Berger

ANDREA J. BERGER
Notary Public, State of New York
No. 31-4[illegible]
Qualified in [illegible] County
Commission Expires [illegible] 30, 1986

Signature: Sherry Mull

Mailed APR 3 1984

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No.

Christensen, O'Connor,
Johnson & Kindness
2701 Westin Building
2001 Sixth Avenue
Seattle, Washington 98121

#2

Ser. No. 378,948

Opposition No. 68,799

Universal City Studios, Inc.

v.

Nintendo of America Inc.

A notice of opposition to the registration sought in the above-identified application has been filed. Copy of the pleading is attached.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE forty days after the mailing date hereof. (See Rule 1.7 for expiration dates falling on Saturday, Sunday, or a holiday).

By direction of the Commissioner.

Emma S. Brown

Deputy Clerk,
Trademark Trial and
Appeal Board

Townley & Updike
Chrysler Building
405 Lexington Avenue
New York, N.Y. 10174

All correspondence including envelopes relating to this proceeding and not accompanied by a fee should be directed to Box 5, Att: TTAB, U.S. Patent & Trademark Office Washington, D. C. 20231.

FORM PTOL-162 (REV. 10-78)

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TRADEMARK TRIAL
AND APPEAL BOARD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 378,948, published in the Official Gazette on December 20, 1983 at TM 323

UNIVERSAL CITY STUDIOS, INC.,

Opposer,

-against-

NINTENDO OF AMERICA, INC.,

Applicant.

Opposition No. 68799

NOTICE OF OPPOSITION

UNIVERSAL CITY STUDIOS, INC. (herein "Opposer"), a Delaware corporation having its principal place of business at 100 Universal City Plaza, Universal City, California, believes that it will be damaged by the registration of the designation DONKEY KONG JUNIOR for "Video Output Game Machines and Parts Therefor" shown in Application Serial No. 378,948, and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Opposer, through its "Universal Pictures" division is engaged generally in the business of producing and

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distributing motion pictures for theatrical and other types of exhibition in the United States and throughout the world. Through its corporate affiliate, Merchandising Corporation of America, Inc. (herein "Merchandising"), Opposer is also engaged generally in the business of licensing the use of various Universal trademarks, service marks, symbols, trade names and characters owned by Opposer for the use by others in connection with the sale of articles of merchandise and services.

2. By virtue of certain agreements and written assignments entered into between Opposer and RKO General, Inc. and Opposer and the heirs of Merian C. Cooper, Opposer is the owner of all trade names, trademark, service mark and other rights in the name, character and story of KING KONG, created and developed by Merian C. Cooper prior to 1933 and produced and released as motion picture under the name "KING KONG" by RKO Radio Pictures Inc. in 1933, and subsequently as a remake motion picture under that name by Dino DeLaurentiis Corporation in 1976.

3. During the 1960's, RKO -- Opposer's predecessor in interest -- licensed the production of other motion pictures featuring the character KING KONG, one entitled "KING KONG VERSUS GODZILLA" a second entitled "KING KONG ESCAPES" and an animated television series entitled "THE KING KONG SHOW."

4. The name KING KONG denotes a gigantic gorilla and the story of King Kong, as made popular by the story of Merian C. Cooper and motion pictures of RKO and Dino DeLaurentiis -- to whose rights in KING KONG Universal has succeeded -- tells of the gorilla's discovery by an American movie crew on an island in the South Pacific, his subsequent capture and transport to New York and the gorilla's attachment for the female star of the film. Among the most popular and famous scenes of the "KING KONG" motion pictures produced by RKO and Dino DeLaurentiis is King Kong at the top of a large building holding the female lead of the film captive while attempting to repel the efforts of others to rescue her.

5. Both the RKO 1933 and Dino DeLaurentiis 1976 "KING KONG" motion pictures were extensively advertised and promoted throughout the United States and both are currently offered for sale and rental to the public in the form of video cassettes. Both motion pictures have acheived and enjoyed enormous nationwide popularity and commercial success, the 1933 RKO "KING KONG" having been continuously exploited by RKO and its licensees for the past 50 years and the 1976 remake "KING KONG" having been continuously exploited by RKO licensees for the past 8 years, through theatrical and television exhibition.

6. At least as early as 1933, and long prior to July 6, 1981, the date of first use claimed by applicant, Opposer

and its predecessor in interest have commercially developed and exploited the KING KONG name in motion pictures and have continuously used in interstate commerce the name KING KONG, the character KING KONG and elements of the KING KONG story in association with the other motion pictures and television shows as previously described and in the advertising and sale of consumer products and services, including various toys, posters and sundry items.

7. As a result of the extraordinary popularity and commercial success of the original 1933 "KING KONG" motion picture, the KING KONG motion pictures of the 1960's, the "KING KONG" remake motion picture of 1976 and the KING KONG television shows and consumer products licensed by RKO Pictures and RKO, and the extensive advertising and promotion undertaken in connection therewith, the KING KONG name, character and story, including the visual image of a giant gorilla atop a tall building, have become, and are, well known to the public, and are associated and identified by the public with their creators to whose rights therein Opposer has succeeded, is now owner and has expanded upon as described infra.

8. As a result of the foregoing activities, the name KING KONG, the gorilla character KING KONG and visual image of KING KONG atop a large building have become, and are, well known to the public in connection with motion pictures,

television shows and consumer products and services, including especially products and services in the entertainment fields, all of which the public identifies as deriving from a single origin and source.

9. Opposer has expanded on the promotions and commercial efforts of its predecessors with respect to KING KONG by licensing the KING KONG name and KING KONG character to Tiger Electronics, Inc., for use by the latter in the manufacture and sale of a home video game and cassette which feature the KING KONG name and character of the gorilla KING KONG, by licensing the KING KONG name and KING KONG character to National Electronics & Watch Co., Ltd., for use by the latter in the manufacture and sale of wrist game watch which will feature the KING KONG name and character of the gorilla KING KONG, and by authorizing Robert Keith & Co. to display a KING KONG balloon on top of the Empire State Building in conjunction with the 50th anniversary celebration of the 1933 RKO movie.

10. Opposer is the owner of the trademark "KING KONG" registered in the United States Patent and Trademark Office under No. 1,076,514, on November 1, 1977 for "Toy Animal Figures and Playsets." This trademark registration was duly assigned by the Mego Corporation, the original owner of the trademark, to RKO General, Inc., Opposer's predecessor in interest. RKO General, Inc. duly assigned the trademark to Opposer on January 3, 1983.

11. The aforesaid registration is valid and subsisting, unrevoked and uncancelled. Opposer is the owner of the trademark and the registration and all the business and goodwill connected therewith in the United States. Pursuant to Rule 2.122(d)(2) of the Trademark Rules of Practice, Opposer will make this registration part of the record by filing a notice of reliance on the registration, accompanied by a status and title copy of the registration, during Opposer's testimony period.

12. By the application herein opposed, the applicant seeks to register the designation DONKEY KONG JUNIOR for "Video Output Game Machines and Parts Therefor."

13. The goods to which applicant's mark is applied are closely related to the goods and services using the KING KONG trademark owned by Opposer and move through the same channels of trade as Opposer's goods.

14. Applicant's said mark DONKEY KONG JUNIOR so nearly resembles the KING KONG name and trademark KING KONG as to be likely, when applied to applicant's goods, to cause confusion, to cause mistake and to deceive, with consequent injury to Opposer, to the trade and to the public.

15. Opposer will be damaged by the registration sought by applicant because such registration will assist and

support applicant in the confusing and misleading use of the mark sought to be registered and will create statutory rights in the applicant in violation and derogation of the prior rights of Opposer.

WHEREFORE, Opposer believes that it will be damaged by the registration of applicant's mark and prays that the application for registration be denied.

TOWNLEY & UPDIKE

Dated: January 18, 1984

BY: Mary D. Faucher
Attorney for Opposer
405 Lexington Avenue
New York, N.Y., 10174

OF COUNSEL:

Douglas C. Fairhurst, Esq.
Mary D. Faucher, Esq.
Sandra Edelman, Esq.

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service as first class mail in an evelope addressed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

on January 18, 1984.

Sandra Edelman

Sandra Edelman, Esq.

January 18, 1984
Date

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EDWARD W. SCHALL
COUNSEL

January 18, 1984

Op. 68799

Commissioner of Patents and Trademarks
Washington, D.C. 20231

To The Commissioner:

Enclosed please find three (3) copies each of the two (2) Notices of Opposition to, respectively, Application Serial No. 378,948, published in the Official Gazette on December 20, 1983 at TM 323 and Application Serial No. 390,408, published in the Official Gazette on December 20, 1983 at TM 324, and two (2) certified checks, Nos. 26352 and 26353 in the amount of $400.00 each to cover the filing fees for each Notice of Opposition.

Very truly yours,

Sandra Edelman

Sandra Edelman

SE:dmm
Encl.